

REMARKS

Claims 14 and 16-37 are currently pending in the application, and all claims stand rejected. Applicants propose herein to amend claims 14, 16, 19-25, 28, and 30-35, to cancel claims 26, 27, 29, 36, and 37, and to add new claims 38 and 39. Applicants respectfully request reconsideration of the application in view of the amendments set forth herein and the accompanying remarks.

Rejections Under 35 U.S.C. § 112

Claims 14 and 16-37 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, the Examiner states that there is “no apparent distinction between ‘objects’ and ‘defined objects’ because inherently, all ‘objects’ must be defined” and, further, that “[c]lear terminology must be employed to provide a distinction.” Office Action, at Page 2. It is respectfully submitted that this rejection has been overcome by the claim amendments proposed herein.

Double Patenting Rejection

Claims 14, 16-21, 25-31, and 35-37 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of United States Patent 5,956,736.

Pursuant to 37 C.F.R. § 1.130, a terminal disclaimer is filed with this response to overcome the non-statutory double patenting rejection. The filing of this terminal

disclaimer should not be construed as an admission by Applicants regarding the propriety of this double patent rejection.

Obviousness Rejections Under 35 U.S.C. § 103

To reject a claim or claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. When establishing a prima facie case of obviousness, the Examiner must set forth evidence showing that the following three criteria are satisfied:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Also, the evidentiary showing of a motivation or suggestion to combine prior art references "must be clear and particular." *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Obviousness Rejection Based on United States Patent 5,745,113 to Jordan et al.

Claims 14 and 16-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent 5,745,113 to Jordan et al. (hereinafter "Jordan").

Claims 26, 27, 29, 36, and 37 are canceled herein. Applicants respectfully traverse this rejection with respect to the remaining claims, as set forth below.

Claim 14, as amended, recites:

14. (Twice Amended) A desktop publishing system, comprising:
an output display device, the output display device displaying:
a *first list of objects*, the first list of objects *including a predefined object*;
a *second list of objects*, the second list of objects *including a user defined object*;
a view window for displaying a page comprising one object from one of
the first and second lists of objects; and
an input device, the input device selecting the one object from one of the first
and second lists of objects for display in the page.

Each of independent claims 20 and 31 recites some limitations similar to those recited in independent claim 14.

Jordan discloses a system for recording and displaying information about work practices. Column 1, Lines 44-46. The system includes a map editor, and this map editor includes a number of predefined objects (e.g., representing objects found in a typical office setting) which appear in palettes. Column 6, Lines 40-43. An object may be selected and added to a map in a drawing pane. Column 6, Lines 30-33. The map editor is illustrated in FIG. 2, which shows an object palette **30** including a single list of predefined objects, and only a limited number of objects may be selected by the user to appear in the map editor. Column 6, Lines 43-45. Using an object editor, a user can

create user defined objects by selecting an object and editing how that object is displayed in a map. Column 7, Lines 19-26.

The Jordan patent does not, however, disclose a system that organizes and displays objects in separate lists. In contrast, claim 1 (and claims 20 and 31) of the present application claims a publishing system having at least a first list of objects and a second list of object, wherein the first list includes a predefined object and the second list includes a user defined object. The ability to organize objects – for example, according to whether they are predefined or user defined – and display them in separate lists is an important feature of the presently claimed invention. As stated in the as-filed specification (at page 24, lines 11-24):

It is possible to drag and drop an HTML object from widgets panel 502 to user panel 501. The user may first choose to modify a predefined HTML object from widgets panel 502, rename it, and store it in user panel 501. The predefined HTML object is modified by the user first dragging the HTML object to an object editor window, as described in more detail below. This *allows a user to reuse a predefined HTML object*, such as a header, by modifying a property or handler associated with the predefined HTML object, and creating a new user-defined HTML object that is identical to the predefined HTML object with the exception of the modified property or handler. *This ability is fundamental to the concept of software reuseability in object oriented programming. The ability to click and drag on a predefined object for the purpose of reusing the object to create custom objects provides for efficient construction of Web documents.*

These concepts of reuseability and efficient document construction are facilitated by the above-noted feature recited in independent claims 1, 20, and 31 – i.e., the ability to display to a user separate lists of objects – and this feature is not taught or suggested by Jordan. Rather, Jordan discloses a system that displays a single list to a user, wherein this list displays only a limited number of objects and does not distinguish between different categories of objects (e.g., between predefined objects and user defined objects). Further, by displaying objects in a single list, it would seem that Jordan teaches away from the presently claimed invention. *See* M.P.E.P. §2145(X)(D) (stating that a prior art reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness); M.P.E.P. §2141.02 (stating that a prior art reference must be considered in its entirety including portions that would lead away from the claimed invention); and M.P.E.P. §2143.01 (stating that a proposed modification to a prior art reference cannot change the principle of operation of the prior art reference).

Therefore, as Jordan fails to disclose at least the above-noted limitations of independent claims 14, 20, and 31, respectively, each of these claims is nonobvious in view of Jordan. Also, if an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Accordingly, claims 16-19, 38, and 39 are allowable as depending from nonobvious, independent claim 14, claims 21-25, 28, and 30 are allowable as depending from nonobvious, independent claim 20, and claims 32-35 are allowable as depending from nonobvious, independent claim 31.

CONCLUSION

Applicants submit that claims 14, 16-25, 28, 30-35, 38, and 39 are in condition for allowance and respectfully request allowance of such claims.

Please charge any shortages and credit any overages to our Deposit Account No. 02-2666.

Respectfully submitted,

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MARKED-UP VERSION OF CLAIMS

14. (Twice Amended) A desktop publishing system, comprising:
an output display device, the output display device displaying:
[a palette window comprising a defined objects panel comprising a list of
defined objects and an objects panel comprising a list of objects, wherein
the defined objects panel further comprises a user defined objects panel
comprising a list of user defined objects;]
a first list of objects, the first list of objects including a predefined object;
a second list of objects, the second list of objects including a user defined
object;
a view window for displaying a page comprising one object from one of the
[list of defined objects and the list] first and second lists of objects; and
an input device, the input device selecting the one object from one of the [list of
defined objects and the list] first and second lists of objects for display in the
page.

16. (Twice Amended) The desktop publishing system of claim 14, wherein the
[objects panel comprising a list of objects comprises a predefined objects panel
comprising a list of predefined objects] first list of objects and the second list of objects
are displayed in a palette window.

17. (Amended Once) The desktop publishing system of claim 14, wherein the input
device is a mouse.

18. (Amended Once) The desktop publishing system of claim 14, wherein the input device is a keyboard.
19. (Twice Amended) The desktop publishing system of claim 14, wherein the output display device further displays an object editor window, the object editor window displaying a list of properties associated with the one object [from one of the list of defined objects and the list of objects].
20. (Twice Amended) In a desktop publishing system, a computer mediated method of generating and displaying a collection of objects representing a document, comprising:
[displaying a list of objects in a palette window on a display device, comprising:]
displaying a first list of [defined] objects [in a defined objects panel in the palette window wherein the defined objects panel further comprises a user defined objects panel comprising a list of user defined objects], the first list including a predefined object;
displaying a second list of objects [in an objects panel in the palette window], the second list of objects including a user defined object;
receiving input from an input device selecting an object from one of the [list of defined objects and the list] first and second lists of objects for the collection of objects; and
displaying the collection of objects in a page displayed in a view window of the display device, including the selected object.

21. (Twice Amended) The method of claim 20, wherein receiving input from an input device selecting an object from one of the [list of defined objects and the list] first and second lists of objects for the collection of objects further comprises a mouse clicking on the object in the one of the [list of defined objects and the list] first and second lists of objects.

22. (Twice Amended) The method of claim 20, [wherein displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of objects in an objects panel in the palette window, comprises displaying a list of user defined objects in a user defined objects panel in the palette window and displaying a list of objects in an objects panel in the] further comprising displaying the first and second lists of objects in a palette window.

23. (Twice Amended) The method of claim 20, wherein [displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of objects in an objects panel in the palette window, comprises displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of predefined objects in a predefined objects panel in the palette window] the user defined object is created from the predefined object.

24. (Twice Amended) The method of claim [23] 20, wherein [displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of predefined objects in a predefined objects panel in the palette window, comprises displaying a list of user defined objects in a user defined objects panel in the palette window and displaying a list of predefined objects in a predefined objects panel in the palette window] the user defined object is created from another user defined object.

25. (Twice Amended) The method of claim 20, further comprising:
receiving [input via] at the input device[, the] input selecting [the] an object from one of the first and second lists of objects for modifying a property associated with the object;
displaying in an object editor window in the display device a value of the property associated with the object; and
receiving at the input device input modifying the value of the property associated with the object.

26. (Canceled) The method of claim 25, wherein receiving input via the input device, the input selecting the object for modifying a property associated with the object comprises receiving input via the input device, the input selecting the object from one of the list of defined objects and the list of objects in the palette window.

27. (Canceled) The method of claim 26 further comprising:

receiving input selecting one of the objects from the lists of defined objects and the objects, the selected object having a property associated with the selected object, the property having a value identical to the modified value of the property associated with the selected object; and
displaying the selected object in the defined objects panel in the palette window.

28. (Twice Amended) The method of claim 25, wherein receiving input [via the input device, the input selecting the object for modifying a property associated with the object] comprises receiving [input via] at the input device[, the] input selecting the object for modifying the property from the collection of objects in the page displayed in the view window of the display device.

29. (Canceled) The method of claim 28, wherein receiving at the input device input modifying the value of the property associated with the object further comprises displaying the object in the collection of objects in the page displayed in the view window of the display device.

30. (Twice Amended) The method of claim 21, wherein displaying the collection of objects in a page displayed in a view window of the display device, including the selected object, comprises the mouse dragging the object from the one of the [list of defined objects and the list] first and second lists of objects and dropping the object in the collection of objects in the page of the view window of the display device.

31. (Twice Amended) An article of manufacture comprising a computer usable medium having computer readable program code means embodied therein for causing a processor to generate and display a collection of objects representing a document, comprising:

computer readable program code means for displaying a first list of objects [in a palette window on a display device, comprising displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of objects in an objects panel in the palette window, wherein the defined objects panel further comprises a user defined objects panel comprising a list of user defined objects], the first list of objects including a predefined object;

computer readable program code means for display a second list of objects, the second list of objects including a user defined object;

computer readable program code means for receiving input from an input device selecting an object from one of the [list of defined objects and the list of objects for the collection] first and second lists of objects; and

computer readable program code means for displaying the collection of objects in a page displayed in a view window of the display device, including the selected object.

32. (Twice Amended) The article of manufacture of claim 31, [wherein the computer program code means for displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of objects in an objects panel in the palette window, comprises computer program code means for displaying a list of user defined objects in a user defined objects panel in the palette window and displaying a list of objects in an objects panel in the] further comprising computer readable program code means for displaying the first and second lists of objects in a palette window.

33. (Twice Amended) The article of manufacture of claim 31, [wherein the] further comprising computer readable program code means for [displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of objects in an objects panel in the palette window, comprises computer program code means for displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of predefined objects in a predefined objects panel in the palette window] creating the user defined object from the predefined object.

34. (Twice Amended) The article of manufacture of claim [33] 31, [wherein the] further comprising computer readable program code means for [displaying a list of defined objects in a defined objects panel in the palette window and displaying a list of predefined objects in a predefined objects panel in the palette window, comprises computer program code means for displaying a list of user defined objects in a user defined objects panel in the palette window and displaying a list of predefined objects in a predefined objects panel in the palette window] creating the user defined object from another user defined object.

35. (Twice Amended) The article of manufacture of claim 31, further comprising:
computer program code means for receiving [input via] at the input device[, the]
input selecting [the] an object from one of the first and second lists of objects
for modifying a property associated with the object;
computer program code means for displaying in an object editor window in the
display device a value of the property associated with the object; and
computer program code means for receiving at the input device input modifying
the value of the property associated with the object.

36. (Canceled) The article of manufacture of claim 35, wherein the computer program code means for receiving input via the input device, the input selecting the object for modifying a property associated with the object comprises computer program code means for receiving input via the input device, the input selecting the object from one of the list of defined objects and the list of objects in the palette window.

37. (Canceled) The article of manufacture of claim 36 further comprising:

computer program code means for receiving input selecting one of the objects from the lists of defined objects and the objects, the selected object having a property associated with the selected object, the property having a value identical to the modified value of the property associated with the selected object; and

computer program code means for displaying the selected object in the defined objects panel in the palette window.

38. (New) The desktop publishing system of claim 14, wherein the user defined object is created from the predefined object.

39. (New) The desktop publishing system of claim 14, wherein the user defined object is created from another user defined object.